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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,290	08/18/2003	Colin Charles Owen Goble	978-72	2016

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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/642,290

**Applicant(s)**

GOBLE, COLIN CHARLES OWEN

**Examiner**

Michael Peffley

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

Applicant's remarks, received July 25, 2006, have been fully considered by the examiner now of record. The current examiner of record has reviewed the claims and performed a new search, and the claims will now be rejected with new prior art. As a result, the instant application is non-final.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ichikawa et al (5,540,683).

Ichikawa et al provide an electrosurgical system including a generator (20) for generating RF energy, and an instrument (42) having at least two electrodes and an identification element (see col. 4, lines 23-37) that identifies the instrument, including the number of electrodes (i.e. bipolar or monopolar). The generator has an RF output stage (i.e. connectors 130, 132 and 62) and a switching circuit (75c) that couples at least two outputs to the electrodes being used (see Figure 6). A sensing circuit (78a, 78b, 78c) identifies the instrument, and the switching circuit connects the RF output to the appropriate and controls the delivery of energy based on the particular identification element carried by the instrument. Ishikawa et al also disclose a variety of endoscopic devices carrying one or more electrodes, including an embodiment with a hook (Figures 12-14).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 11, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panescu et al (6,165,169) in view of the teaching of Ichikawa et al ('683).

Panescu et al disclose an electrosurgical system comprising a generator (176) for generating RF energy, and an electrosurgical instrument (10) that includes several electrodes. The instrument carries an identification element (170) that identifies numerous parameters of the instrument, including the number of electrodes (see col. 3, lines 15-20). The generator inherently includes an output stage coupling the leads in the connector (32) to the electrodes, and a power supply. A controller (174) varies the signal supplied to the RF output lines based on the sensed identification code and also serves as the switching circuit to control the delivery of energy to the output lines. A sensing circuit (178) senses the identification element and works in concert with the signal processor to deliver the appropriate energy to the electrodes. Panescu et al disclose the use of numerous types of identification storage devices, including resistors and capacitors (col. 3, lines 1-10 and col. 26, lines 65+). While the examiner maintains that the Panescu et al system must inherently include a plurality of outputs for connecting the numerous different electrodes coupled to the instrument through connector (32), there is no express disclosure of the connection and switching circuit that provides the energy to the connected device.

As addressed previously, Ishikawa et al disclose an analogous system that includes an RF instrument having an identification means for relaying to the generator what type of device is attached, as well as the number of electrodes (i.e. bipolar or monopolar). In particular, Ishikawa et al specifically show one type of switching device used to connect the generator to the output to provide RF energy to the device. Again, the examiner maintains that the Panescu et al device inherently has such a switching system to provide connection between the generator and the multiple electrodes. However, the Ishikawa et al system is relied upon to show that it is generally known to include such a switching mechanism in a system that identifies an electrosurgical instrument and controls the connection and delivery of energy to the electrodes based on the identification code detected.

To have provided the Panescu et al system with a switching mechanism to allow for the connection of the detected electrodes to the generator system would have been an obvious consideration for one of ordinary skill in the art in view of the teaching of Ishikawa et al.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Panescu et al ('169) and Ishikawa et al ('683) as applied to claim 3 above, and further in view of the teaching of Quinn et al (5,720,293).

The combination of the Panescu et al system with the Ishikawa et al teaching has been addressed previously. While Panescu et al disclose numerous different identification means, both digital and analog, there is no specific disclosure of using an inductor to provide the identification code.

Quinn et al disclose a catheter system that includes an identification means. In particular, Quinn et al also disclose the use of resistors and capacitors to identify the device, and also specifically teach of the use of inductors to provide the identification of the catheter device to the system (see col. 9, lines 30-35).

To have provided the Panescu et al system, as modified by the teaching of Ishikawa et al, with an inductor as the identification means would have been an obvious alternative for one of ordinary skill in the art in view of the teaching of Quinn et al.

Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichikawa et al ('683) in view of the teaching of Shlain (5,460,629).

Ichikawa et al teach that any of a variety of endoscopic RF devices may be used with the system. Ichikawa et al specifically disclose one embodiment that includes a hook member, but fails to specifically disclose a device with multiple and/or movable hook members.

Shlain discloses another endoscopic RF device. Shlain, in particular, disclose various arrangements for the electrodes including multiple electrode hooks (Figure 21B) whereby one electrode may extend beyond another. The examiner maintains that such a system as taught by Shlain may obviously be used in the Ichikawa et al system that clearly suggests the use of any known electrosurgical device with the system.

To have provided the Ichikawa et al system with a multiple hook endoscopic device for the RF treatment of tissue would have been an obvious consideration for one

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of ordinary skill in the art, particularly since Shlain teaches such endoscopic instruments are known.

### ***Response to Arguments***

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

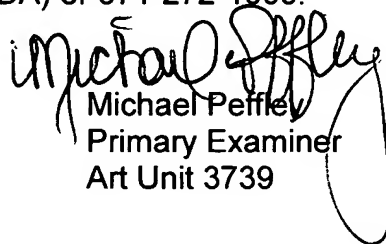
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stern et al (5,743,903) and Qin et al (6,464,689) disclose other RF systems that include an identification means for identifying and controlling the operation of surgical instruments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
September 9, 2006